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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,625	10/07/2003	Tommy Grigsby	2002-IP-009328 U1 USA	5552
20558	7590	06/27/2005	EXAMINER	
KONNEKER & SMITH P. C. 660 NORTH CENTRAL EXPRESSWAY SUITE 230 PLANO, TX 75074			LE, THANH TAM T	
			ART UNIT	PAPER NUMBER
			2839	

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

H.A

<b>Office Action Summary</b>	<b>Application No.</b> 10/680,625	<b>Applicant(s)</b> GRIGSBY ET AL.	
	<b>Examiner</b> Thanh-Tam T. Le	<b>Art Unit</b> 2839	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2005.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-88 is/are pending in the application.
- 4a) Of the above claim(s) 6,7,12,13,19,37-45,58-69 and 80 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,8,10,11,14-17,20-36,46-57,70-79 and 81-88 is/are rejected.
- 7) ☒ Claim(s) 9 and 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5, 8, 10-11, 14-17, 20-36, 46-57, 70-79 and 81-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Restarick et al. (6,766,853).

Regarding claims 1, 11, 46 and 70, Restarick et al., figure 1, disclose a system comprising a first fiber optic connector (28) position in a well; and a second fiber optic connector (30) operatively connected to the first optic connector after the first fiber optic connector is positioned in the well.

Restarick et al. disclose the instant claimed invention as described above except for a connection between the first and second fiber optic connectors being made after the first and second fiber optic connectors are positioned in the well.

In absence of any showing criticality of the applicant, to provide Restarick et al. to have the connection between the first and second fiber optic connectors being made after the first and second fiber optic connectors are positioned in the well would have been obvious of modification since such change provides unexpected result.

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Regarding claims 2 and 20, figure 7, the first fiber optic connector is operatively coupled to a fiber optic line (84) that is configured to sense a downhole parameter.

Regarding claims 3 and 21, figures 1 and 7, the first fiber optic connector is operatively coupled to a fiber optic line (84) that has a sensor (22) connected thereto.

Regarding claims 4 and 5, the first and second fiber optic connectors are attached to a first and second downhole assemblies; and the first and second assemblies are attached to each other and rotationally oriented with respect to each other prior to operatively connecting the first and second fiber optic connectors.

Regarding claims 8 and 17, at least one of the first and second fiber optic connectors is operatively coupled to a fiber optic line (84) extending longitudinally through a packer (18).

Regarding claims 10, 14 and 22, the first fiber optic connector is attached to a tubular string (12); and the second fiber optic connector is attached to an assembly received within the tubular string.

Regarding claim 15, the second assembly is conveyed on a running tool through the tubular string (column 3, lines 12-16).

Regarding claims 16 and 23, pressure applied between the running tool and the tubular string causes the first and second fiber optic connectors to operatively connect with each other.

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Regarding claims 24-26, the second assembly extends into a third assembly positioned in the well and the third assembly is a gravel packing assembly (18).

Regarding claims 32-36 and 83-88, the features in the method claims are identical to those in the apparatus claims. Therefore, the method of making fiber optic connections in a subterranean well alone is not a patentable feature.

***Allowable Subject Matter***

3. Claims 9 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

4. The following is an examiner's statement of reasons for allowance:

None of the reference discloses the first optic connector is operatively coupled to a first fiber optic line positioned external to a tubular string, and the second fiber optic connector is operatively connected to a second fiber optic line positioned internal to the tubular string, in combination with the other claimed elements of the embodiments recited.

5. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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***Response to Arguments***

6. Applicant's arguments with respect to claims 1, 11, 46 and 70 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh-Tam T. Le whose telephone number is 571-272-2094. The examiner can normally be reached on 7:30-5:00.

8. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, TC Patel can be reached on 571-272-2098. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TL.  
06/22/05.

  

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T. Le